

Application No.: 10/777310

Case No.: 58232US004

REMARKS

Claims 21 and 30 to 43 are pending and are under consideration.

Claim 21 has been amended to recite particular chemical classes of TLR8 agonists. The amendment is fully supported by the specification at, for example, from page 14, line 11 through page 19, line 7, and claims 30-44.

§ 112 Rejections**Written Description**

Claim 21 stands rejected under 35 USC § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 21 has been amended to recite particular chemical classes of TLR8 agonists, each of which is specifically disclosed in Applicants' specification. The specification reasonably conveys to those skilled in the art that Applicants possessed the full scope of the claimed invention. Applicants respectfully request that the rejection of claim 21 under the written description requirement of 35 USC § 112, first paragraph, be withdrawn.

Enablement

Claim 21 stands rejected under 35 USC § 112, first paragraph, as not reasonably providing enablement for the full scope of the claimed subject matter. The Office Action acknowledges that the specification is enabling for the specific TLR8 agonists recited in the dependent claims or disclosed in the specification, but asserts that the specification is not enabling for any or all TLR8 agonists.

Claim 21 has been amended to recite chemical classes of TLR8 agonists, each of which is specifically disclosed in Applicants' specification. Thus, Applicants submit that the specification enables the full scope of the claimed subject matter. Applicants respectfully request that the rejection of claim 21 under the enablement requirement of 35 USC § 112, first paragraph, be withdrawn.

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In summary, Applicants' specification meets the written description and enablement requirements of 35 USC § 112, first paragraph, with respect to the claimed subject matter. Consequently, Applicants respectfully request that the rejections be withdrawn.

§ 102 Rejections

Claim 21 stands rejected under 35 USC § 102(b) as being anticipated by Dockrell *et al.* ("Dockrell"). Dockrell teaches the use of imidazoquinolines imiquimod and resiquimod to induce cytokine production *in vitro* and *in vivo*.

Claim 21 has been amended to recite particular chemical classes of TLR8 agonists. The classes recited include "substituted imidazoquinoline amine," which is defined in Applicants disclosure specifically to exclude imiquimod and resiquimod (page 17, lines 6-16). Accordingly, Dockrell does not anticipate claim 21, as amended.

The rejection of claim 21 under 35 USC § 102(b) as being anticipated by Dockrell has been overcome and should be withdrawn.

Obviousness-type Double Patenting

Claim 21 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1, 5, and 8 of copending U.S. Patent Application No. 10/788,731 ("the '731 application"). Applicants will defer providing a response to the provisional rejection until receiving an indication of otherwise allowable subject matter. Applicants note, however, that the present application has a priority date (February 13, 2003) that is earlier than the priority date of the '731 application (February 27, 2003).

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 21 and 30 to 43 at an early date is solicited.

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Date

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Respectfully submitted,

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